

In re Appln of NESPER CO. (Applicant)
Appln. No. 10/544,211
Reply dated January 7, 2010
Reply to Office Action of July 8, 2009

REMARKS

The Official Action of July 8, 2009, and the prior art relied upon therein have been carefully reviewed. The claims in the Application remain as claims 1-3 and 5-22; and the withdrawn claims should be rejoined and all the claims should be allowed. Favorable reconsideration and allowance are earnestly solicited. Applicants have petitioned for a three months' suspension.

Acknowledgment by the PTO of the receipt of Applicants' papers filed under §119 is noted. Filed herewith is a verified translation of the priority application.

The restriction requirement has been repeated and made final. However, the sentence explaining the Examiner's position is incomplete. Accordingly, Applicants again respectfully request withdrawal of the requirement or at least rejoining of the withdrawn claims.

Moreover, Applicants do not understand why claim 11 has been withdrawn, as it falls within the elected Group I, i.e. it is drawn to a process of producing the ceramic from a borazine precursor.

Applicants have requested withdrawal of the requirement and rejoining of the claims. It should be noted that the Group II claims are basically product-by-process claims (or perhaps hybrid product-by-process claims) which should be kept with the elected process. Everything recited in claim 12 inherently follows from the process, even the recitation that the ceramic is substantially pore-free, noting Applicants' specification at page 2, line 14.

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Applicants have noted the Examiner's suggestion regarding the use of headings in the specification, and appreciate the Examiner's thoroughness. However, Applicants believe that headings are unnecessary in the present application, and therefore no amendments to the specification are being made at the present time.

Claims 1, 5-8, 10, 17 and 19 have been rejected as obvious under §103 from Jansen et al USP 7,148,368 (Jansen). This rejection is respectfully traversed.

The Examiner acknowledges in paragraph 15 on page 6 of the Office Action that "Jansen may not explicitly teach tris(hydrosilylvinyl) borazine,...." Actually, Jansen does not disclose Applicants' specific borazines, and therefore does not teach the use of Applicants' precursor, which is an absolutely essential aspect of the present invention.

As the Examiner correctly notes, the closest Jansen comes is with Formula X at col. 5, lines 15-30, which Formula X of course includes an absolutely immense number of possibilities (permutations and combinations). This is at best a huge "shotgun" or "basket" disclosure which does not lead the person of ordinary skill in the art to or toward the present invention. Indeed, the possibility of a vinyl (ethenyl) group is not even mentioned.

Applicants respectfully submit that Formula X relates to a chemical family which is quite different from the claimed B-tris(hydrosilylvinyl) borazines, and that such claimed borazine precursor cannot be reasonably made from Formula X. As Jansen does not disclose the claimed precursor, and does not

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explain what to do so as to lead the person of ordinary skill in the art to the present invention, claim 1 and all the claims which depend therefrom define both novel and unobvious subject matter over Jansen.

Further to the nonobviousness of the present invention, it is highly surprising that it provides ceramic yields which are very high, e.g. up to 94% as stated in the Haberecht publication (see the abstract on page 418 and the conclusion on page 423), which is based on the present invention. Such very high yields could not have been predicted or foreseen from the prior art.

Another advantage, also confirmed by the experimental results set forth in the Haberecht publication (see the abstract on page 418) is the production of a very compact ceramic material. As stated in Applicants' specification at page 2, line 14, the ceramic produced according to the present invention is "essentially pore-free and displays only minimal shrinkage in the conversion into a high-temperature ceramic."

The present invention is not made obvious by Jansen. Withdrawal of the rejection is in order and is respectfully requested.

Claims 2 and 3 have been rejected as obvious under §103 from Jansen in view of Krummland (Reference U), Klein et al USP 5,455,367 (Klein) and Haberecht et al (Reference V), hereinafter simply "Haberecht." Also, claims 9 and 18 have been rejected under §103 as obvious from Jansen in view of Paine et al USP 5,188,757 (Paine) and Haberecht. These rejections are respectfully traversed.

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Both of these rejections depend on the availability of Haberecht as "prior art." However, Haberecht is not prior art to the present application, but instead it is based on the present application (it may be noted that two of the authors of the Haberecht publication, namely Haberecht and Nesper, are co-authors of the Haberecht publication). To remove the Haberecht publication as "prior art", Applicants have filed herewith a verified translation of the Swiss priority application, thereby providing an effective date for the present invention of February 3, 2003, much earlier than the effective date of the Haberecht publication. As a key "reference" is removed from these rejections, the rejections do not apply.

Applicants should also mention that Krummland also does not disclose B-tris(hydrosilylvinyl) borazine as a precursor as required according to claim 1. Krummland teaches a new class of borazines assessable by catalytic hydrosilation, by which it is not possible to make the required B-tris(hydrosilylvinyl) borazine. Paine and Klein also do not make up for the deficiencies as pointed out above.

Withdrawal of the rejections is in order and is respectfully requested.

The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of Applicants' claims.

Applicants believe that all issues raised in the Official Action have been addressed above in a manner that

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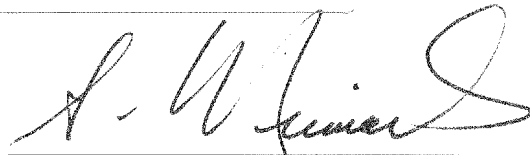
should lead to patentability of the present application.
Favorable consideration and early formal allowance are
respectfully requested.

If the Examiner has any questions or suggestions, he
is respectfully requested to contact the undersigned at (202)
628-5197.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicants

By



Sheridan Neimark
Registration No. 20,520

SN:ltm
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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